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#11

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/184,418	11/02/98	HAHN	B 3532-4000

HM22/1205

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NEW YORK NY 10154

EXAMINER	
ZEMAN,R	
ART UNIT	**PAPER NUMBER**
1645	11

DATE MAILED: 12/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/184,418	Hahn et al.
Examiner	**Group Art Unit**
Robert A. Zeman	1645

☒ Responsive to communication(s) filed on *Nov 2, 1998* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *1* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-41* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-41* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

11 X I. 1-11 Claims 1-6, 10, 14 and 33-34, drawn to nucleic acids and kits containing the same, classified in class 536, subclass 23.72.

11 X II. 12-22 Claims 7-9, 11-13 and 15-21, drawn to polypeptides, vectors encoding said peptides, cells containing said vectors and method for expressing said vector, classified in class 530, subclass 350 and class 435, subclass 69.1+.

11 X III. 23-33 Claims 23, 25, 29-30 and 35, drawn to antibodies and kits containing same, classified in class 530, subclass 388.35.

IV. 34-44 Claims 22 and 24, drawn to methods of inducing antibodies (immunizing), classified in class 424, subclass 208.1.

45-55 V. Claims 26-27, drawn to methods of detecting HIV-1 using antibodies, classified in class 435, subclass 5.

56-66 VI. Claims 31-32 and 37, drawn to methods of detecting HIV-1 using nucleic acid hybridization, classified in class 435, subclass 6.

11 X 67-77 VII. Claims 36 and 39, drawn to nucleic acid probes, classified in class 536, subclass 24.32.

78-88 VIII. Claim 28, drawn to method of detecting antibodies, classified in class 435, subclass 5.

IX. ¶¶ Claim 38, drawn to method of detecting HIV-1 using PCR, classified in class 435, subclass 91.2.

X. ¶¶ Claims 40-41, drawn to methods of comparing sequences, classified in class 702, subclass 19.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III and VII are separate and distinct from each other as they comprise completely differing biochemical and physical entities having differing properties and uses. Invention I is drawn to nucleic acids, whereas Invention II to polypeptides and Invention III to antibodies

Invention I is separate and distinct from Invention IV as the substances of Invention I cannot be used in the methods of Invention IV.

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptides of Invention II can be used in other methods such as binding studies.

Inventions IV and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be

made by another and materially different process (MPEP § 806.05(f)). In the instant case the antibodies can made synthetically or isolated from their natural source.

Inventions I-II are separate and distinct from Invention V as the substances of Inventions I-II cannot be used in the methods of Invention V.

Inventions III and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the antibodies of Invention III can be used in other methods such as anti-idiotypic antibody production and affinity purification.

Inventions IV and V are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions II-III are separate and distinct from Invention VI as the substances of Inventions II-III cannot be used in the methods of Invention VI.

Inventions I and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the nucleic acids of Invention I can be used in other methods such as polypeptide production.

Inventions IV-VI are separate and distinct from each other as they are drawn to differing methods having different steps and leading to differing results.

Inventions IV-VI are separate and distinct from Invention VII as the probes of Invention VII cannot be used in the methods of Inventions IV-VI.

Inventions I-III are separate and distinct from Invention X as the substances of Inventions I-III cannot be used in the methods of Invention X.

Inventions IV-VII are separate and distinct from each other as they are drawn to differing methods having different steps and leading to differing results.

Inventions VII and VIII separate and distinct from each other as the nucleic acid probes of Inventions VII cannot be used in the methods of Invention VIII.

Inventions I-III and VII are separate and distinct from Invention IX as the substances of Inventions I-III and VII cannot be used in the methods of Invention IX.

Inventions IV-VI and VIII-IX are separate and distinct from each other as they are drawn to differing methods having different steps and leading to differing results.

Inventions I-III and VII are separate and distinct from Invention X as the substances of Inventions I-III and VII cannot be used in the methods of Invention X.

Inventions IV-VI and VIII-X are separate and distinct from each other as they are drawn to differing methods having different steps and leading to differing results.

This application contains claims directed to the following patentably distinct species of the claimed invention: **nucleic acids sequences listed in Figure 13.**

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can be reached between the hours of 7:30 am and 4:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, Donna Wortman, Primary Examiner can be reached at (703) 308-1032 or the examiner's supervisor, Lynette Smith, can be reached at (703)308-3909.

DONNA WORTMAN
PRIMARY EXAMINER

Robert A. Zeman

November 30, 2000